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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,198

04/06/2004

Ralph Mitchell

27811-002 UTIL

7416

30623

7590

04/22/2008

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C

ATTN: PATENT INTAKE CUSTOMER NO. 30623

ONE FINANCIAL CENTER

BOSTON, MA 02111

EXAMINER

VYAS, ABHISHEK

ART UNIT

PAPER NUMBER

3691

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DELIVERY MODE

04/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,198

Applicant(s)

MITCHELL, RALPH

Examiner

ABHISHEK VYAS

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 04/06/2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application 10/820,198 filed on 04/06/2004.
2. Claim 1-20 are currently pending and have been examined.
3. Claims 1-20 are rejected.

Double Patenting

4. Claims 1-20 of this application (10/820,198) conflict with claims 1-20 of Application No. 11/013,658 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process may obtain a patent therefore..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
6. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 11/013,658. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. In particular, claims 1, 7, 14, 16 and 18 recite in the preamble "*a method of insuring military reserve component personnel*" and "*an insurance policy*". The claims recite: "*collecting payments*" and "*providing desired compensatory income*". It is unclear whether the steps of collecting payments and providing compensatory income are claimed as the novel feature or an actual insurance policy or the provisions within a policy. The functional steps of collecting payments and paying compensations do not specifically encompass the bounds of an insurance policy. Further, it is unclear whether the reservist or the reservist's dependents or the employer are requesting the compensation.
11. Claim 5 is dependent on claim 1, Claim 5 lacks antecedent basis for the term "*the first time period*".
12. Claim 6, is vague and indefinite. It is unclear whether the reservist is paying a replacement to substitute his capacity at his civilian occupation or whether a third entity is insuring itself to provide for the income credited to a replacement hired in lieu of the reservist. Further, it is unclear whether the replacements or employers of reservists are being insured or the reservists themselves according to claim 1.

13. Claim 12, the term "return condition" is vague and indefinite. What are the conditions for return? Death? Draft? Loss of wages? Reduction of wages?
14. Claims 2-3, 8-11, 13, 15, 17, 19-20 are rejected on their dependencies to claim 1, 7, 14, 16 and 18 respectively.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).
17. Claims 1-20 are rejected under 35 USC 101.
18. It is not clear as to which statutory class the claimed invention belongs. Further, the claimed invention as a whole must accomplish a practical application to constitute eligible subject matter. That is, it must produce a "useful, concrete and tangible result." *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). In claims 1-20 there is no tangible real world result. There is no real result or transforming, and concrete outcome.
19. Claims 1-20 are directed towards non-statutory subject matter. An insurance policy is not within a statutory class of a process, machine, manufacture or composition of matter. A policy is interpreted as a legal document, or decree, agreement or contract. A payment that results from this policy is an obligation of the insurer to the policy holder, is likewise not among the four

enumerated categories of statutory subject matter. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. **Claims 1, 7, 14, 16 and 18** are rejected under 35 U.S.C. 102(b) as being anticipated by Non-Patent Literature (**herein after NPL**), Titled: *DoD Reserve Chief Recommends Suspending Mobilization Insurance*, Author: Master Sgt. Stephen Barrett, May 15 1997 (herein after referred to as "**NPL1: Barrett**").

22. **As per claims 1, 7, 14, 16 and 18**, Barrett in NPL1 teaches the following limitations:

- *collecting payments on behalf of a reservist, amounts of the payments being based upon civilian income of the reservist and desired compensatory income during times of active military duty* (see NPL1: Barrett, page 2, paragraph 3, lines 1-4; paragraph 7, lines 1-3).
- *providing the desired compensatory income for the reservist during at least a portion of a first time period of active military duty of the reservist in response to receiving a request for compensatory income on behalf of the reservist* (see NPL1: Barrett, page 2, paragraph 7, lines 1-3; paragraph 8, lines 1-2; page 1, paragraph 7, lines 2-3).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. **Claims 2-3 and 8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett (NPL 1) in view of Hele et al (herein after Hele) United States Patent Application Publication No.: 2002/0120474 A1.
25. **As per claims 2-3, and 8-9**, Barrett discloses a mobilization insurance contract. Barrett does not specifically disclose the following limitations inherent to underwriting an insurance contract. Hele, however, teaches the limitations as follows:
- the payment amounts are further based on at least one personal factor associated with the reservist (see at least Hele paragraphs 0016, 0037 and 0052).
 - the at least one personal factor is at least one of an age of the reservist, length of occupation of the reservist in the reservist's current civilian occupation, length of occupation of the reservist in the reservist's current military occupation, formal academic background of the reservist, marital status of the reservist, number of household dependents of the reservist, military pay grade of the reservist, number of years of military experience, number of years of civilian employment, level of military responsibility, whether and how many troops the reservist commands at the reservist's military occupation, and level of civilian-employment responsibility (see at least Hele paragraphs 0016, 0037 and 0052).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have specifically included various risk or profile gauging indicators, factors and characteristics, well known in the actuarial and underwriting arts to obtain an accurate assessment of the individuals payment upon enactment of the contract (see Hele paragraph 0017-0018, 0038, 0041, 0058).

26. **Claims 4-5, 10-11 and 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett (NPL 1) in view of **NPL 4**: Titled: *SUMMARY OF MAJOR CHANGES TO CHAPTER 55*

DOD 7000.14-R, VOLUME 7A MILITARY PAY POLICY AND PROCEDURES ACTIVE DUTY AND RESERVE PAY VOLUME 7A, Chapter 55, **February 2000** (herein after referred to as **NPL4**)

27. **As per claims 4-5 and 10-13**, Barrett discloses a mobilization insurance contract. Barrett does not specifically disclose the following limitations inherent to underwriting an insurance contract. NPL4, however, teaches the limitations as follows:

- providing the compensatory income is inhibited until at least one of a threshold cumulative total of payments is collected, a second threshold of number of payments is collected, and a third threshold of a designated time period during which payments have been collected elapses (see at least NPL4, page 5, subparagraph 550105 "Deductions" Items A-H)
- a portion of the compensatory income is provided during a second time period after the first time period, wherein the reservist is off active military duty during the second time period (see at least NPL4, page 3, subparagraph 550102 "Entitlement" Items A-B).
- a return of premium provision for returning a portion of the payments collected if at least one return condition is satisfied, the payment amounts further depending upon election of a return of premium option. (See at least NPL4, page 3, subparagraph 550105 F-H).
- the return condition is at least one that no requests for compensatory income are received, and that compensatory income provided under the plan is below a threshold level relative to a sum of payments collected under the insurance plan. (See at least NPL4, page 6, item A; subparagraph 550107 Items A-D).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the terms and conditions for successful execution of the policy. The conditions would prevent undue burden on the insurer and prevent people who don't pay premiums from receiving benefits (see NPL 1 page 2, paragraph 5 and 8)

28. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett (NPL 1) in view of

NPL 6: Titled: Businesses Hurt By Reservist Call-Ups May Apply For SBA Economic Injury Disaster Loans U.S. Newswire, Washington: Aug 23, 2001. pg. 1

- the compensatory income includes a desired replacement income for paying a person to replace the reservist at the reservist's civilian occupation while the reservist is away on active military duty, and wherein the payment amounts further depend upon the desired replacement income (NPL6 page 1, Abstract line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include protection and reconciliation for economic injury caused to institutions of employment of members of the armed forces. One would be motivated to do so to prevent severe financial losses (see at least NPL6 Page 1; Section: FULL TEXT; lines 1-11).

29. **Claims 15, 17, 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett (NPL 1) in view of **NPL 2:** Titled: Unsnarling a reserve Insurance Snafu (herein after referred to as **NPL2**), May 08 1997.

- the amounts of the payments are also based upon civilian income of the reservist (see at least NPL 2 page 1, paragraph 3, page 2, paragraph 3 and 4)
- the amounts of payments are based on at least one of a number of reservists employed in the business and the likelihood of said reservist(s) being called to serve on active military duty (see at least NPL 2 page 2, paragraph 3 and 4)
- the desired compensation is at least partially dependent on at least one of a number of persons mobilized, length of expected mobilization(s), and estimated cost due to the mobilization(s) based upon prior profitability of the business (see at least NPL 2 page 1, paragraph 3, page 2, paragraph 4, bullets 1 and 2; paragraph 6, bullet 2 and paragraph 7, page 3, paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included as one of the factors into the premium estimations the level of required compensation to

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match income levels prior to incorporation into active duty status (see NPL 2 page 1, paragraph 3, and item 1)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abhishek Vyas whose telephone number is 571-270-1836. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Thur, ALT Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abhishek Vyas

Patent Examiner

16 April 2008

AV

/Lalita M Hamilton/

Primary Examiner, Art Unit 3691